APPENDIX

Portions Only of Opinion Pertinent to This Petition

Complete Opinion is Item 3 of Transcript of Record and Proceedings

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1967.

Patent Appeal No. 7986.

Interference No. 94,210.

EDWARD FREDKIN, *Appellant,*

v.

EUGENE H. IRASEK, *Appellee.*

June 27, 1968

WORLEY, *Chief Judge.*

Fredkin appeals from the decision of the Board of Patent Interferences awarding Irasek priority of invention in an interference between Fredkin patent No. 3,105,593[1] and an Irasek application.[2] Fredkin, as the junior party, has the burden of proving his case by a preponderance of the evidence.

The interference involves five counts corresponding to claims 1-5 of the Fredkin patent. The issues include whether the board erred in holding that the evidence Fredkin relies on to prove conception as to all the counts, and reduction to pracice as to counts 1, 2 and 5, prior to the Irasek filing date was inadequate.[3] Also in dispute is

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[1] Issued October 1, 1963 on an application filed September 19, 1960.

[2] Serial No. 12,032, filed March 1, 1960.

[3] Since those holdings were determinative of the priority question, the board did not consider Irasek's evidence of conception and reduction to practice prior to his filing date.

whether the board erred in holding that Fredkin was precluded from questioning the support in the Irasek application for certain recitations in counts 3 and 4.

The invention relates to apparatus for removing a selected information storage card from a stack of such cards, automatically guiding the selected card past information sensing means, and thereafter returning it to the stack. Counts 1, 3 and 4 read:

> 1. Selector apparatus having in combination, a stack of cards containing information at a predetermined position thereon, said cards having at predetermined regions thereof card-coding elements, said elements defining different patterns for the respective cards, a plurality of card-holding members adjacent corresponding coding elements and having means for releasably coupling the holding members to coding elements of said cards, code-selective operating means for preventing the coupling of coding elements of a selected card with corresponding holding members, whereby the selected card may be separated from said stack, means for automatically guiding the selected card apart from said stack along a predetermined path and thereafter returning the selected card to said stack, and information-sensing means disposed along said path in alignment with said predetermined card position for scanning the information contained on the selected card as the selected card follows said predetermined path.
>
> 3. The apparatus of count 1, said information being arranged in a plurality of parallel tracks on said cards, said sensing means having plural scanning elements aligned with corresponding tracks as the selected card is moved along said path past said scanning elements.
>
> 4. The apparatus of count 1, said coupling means being magnetic.

* * *

Fredkin also argues that Irasek has no support in his application for the limitation of "said coupling means being magnetic" in count 4. The board, pointing out

that no motion to dissolve as to count 4 was made during the motion period, ruled that the question was not before it and declined to rule thereon.

Fredkin admits that he did not include count 4 in his motion to dissolve, referring to "a misunderstanding of the Irasek disclosure." However, he urges that "Irasek himself admitted during his testimony that there simply is no disclosure in the Irasek application * * * of a magnetic coupling between a card holding member and coding elements adjacent thereto." It is Fredkin's contention that it was the duty of the board, *sua sponte*, to rule on the matter because of the alleged admission, citing *Smith* v. *Foley* v. *Anderson* v. *Smith*, 1908 C.D. 210, 136 O.G. 847 (Comr. Pat. 1907); *White* v. *Wege*, 44 App. D.C. 495, 1916 C.D. 195, 227 O.G. 1107 (1916); and *Heuberger* v. *Becker*, 27 CCPA 746, 107 F. 2d 601, 43 USPQ 404 (1939).

We think it plain that the action of the board with respect to claim 4 should not be disturbed because the issue was not raised by appropriate motion. While the cited cases indicate that the board may act *sua sponte* in certain circumstances, they also indicate that there are limitations on such action. Thus, the board is free to decline to consider a question of support which is not raised by a party even in a case where it would be appropriate for it to raise the question. As this court stated in *Heuberger* v. *Becker*, supra:

> It is clear that if the Examiner of Interferences [now Board of Patent Interferences] had not raised the question he could properly have ruled that this question would not be considered by him because of failure of appellee to raise it during the motion period.

Also, the Board could hardly have raised the present question *sua sponte* since it was in fact raised by Fredkin. See *Franklin* v. *Hopper*, supra.

It is also apparent that Irasek has not admitted that his application does not support count 4. The language in

Irasek's testimony relied on by Fredkin as admissions involve decidedly different terminology than is present in count 4. Specifically, Irasek answered negatively as to whether he disclosed "magnetic, as distinguished from electro-magnetic, coupling means *as the force between the rods supporting the cards and the notches of the cards*" [Emphasis supplied]. Irasek does disclose the use of an electromagnet to turn cardholding rods to positions releasing the cards and contends that the claim language is broad enough to cover that construction. While Fredkin expresses the fear that Irasek will obtain a patent with an invalid claim, that question is not a matter which can be considered here. *Kleinman* v. *Steinbach*, 38 CCPA 924, 187 F.2d 743, 89 USPQ 151 (1951).

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The decision is *affirmed*.

AFFIRMED